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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/891,474

Filing Date: June 26, 2001

Appellant(s): MCINTYRE ET AL.

Eugene I. Shkurko, Reg. No. 36,678  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed November 29, 2007 appealing from the Office action mailed July 24, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party of interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

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- a) Angiulo et al. US Patent #6,275,829. Previously cited and entered.
- b) Watanabe et al. US Patent #6,578,072. Previously cited and entered.
- c) Uchiyama, US Patent #6,731,341. Previously cited and entered.
- d) Tomat et al. US Patent #6,784,925. Previously cited and entered.
- e) Motoyama et al. US Publication #2001/0054063. Previously cited and entered.
- f) Newton's Telecom Dictionary, definition of "icon", February, 2000. Newly cited and attached.

#### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 9, and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angiulo et al, US Patent #6,275,829 (Angiulo hereinafter), in view of Watanabe et al, US Patent #6,578,072 (Watanabe hereinafter).

As per claim 1, Angiulo teaches substantially the invention as claimed including a system for managing digital images. Angiulo's teachings comprising:

a device for creating an electronic icon (Col 7, lines 28-39. Create thumbnail.) and associating icon with information allowing access with respect to a particular digital media file having said icon

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associated therewith over a communication network by a third party (Col 11, lines 36-49. Associate link to thumbnail for accessing original image by users.).

Angiulo teaches substantial features of the claimed invention including thumbnails associated to original images. However, Angiulo does not explicitly teach that the icon contains information allowing access and information unique to a particular user.

Watanabe teaches of thumbnails containing information unique to users (Col 7, lines 60-65; Col 8, lines 9-19) and information for allowing access to be included with the icon (Abstract; claim 1, Col 8, lines 8-19, 44-57; Col 9, lines 9-19, 34-42).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to have an icon containing information unique to users and information for allowing access. The motivation for the suggested combination is that the combined teachings would enhance Angiulo's system by distinguishing each thumbnail, thus allowing selective viewing of pictures by users, and based on the decision of KSR International Co. V. Teleflex Inc., it would have been obvious to combine the teachings as the combined teachings would achieve a predictable result of allowing searching of thumbnail images as suggested by Watanabe (column 9, lines 9-13).

As per claim 11, Angiulo teaches substantially the invention as claimed including the method for managing digital images by a service provider on a computer of a user over a communication network. Angiulo teachings comprising:

creating an electronic icon (Col 7, lines 28-39. Create thumbnail.) and associating information for allowing access by a third party to a particular digital media file stored on said computer (Col 11, lines 36-49. Associate link to thumbnail for accessing original image for view by users.);

said service provider accessing said computer over said communication and locating digital media files having said icon associated therewith and allowing accessing to said digital media files by

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said third party (Col 9, lines 19-22. Original image stored on computer. Col 11, lines 46-49. Selecting thumbnail results in displaying original image.).

Angiulo teaches substantial features of the claimed invention including associating thumbnails with original images. However, Angiulo does not explicitly teach that the electronic icon contains information for allowing controlled access by a designated party or information unique to said user.

Watanabe teaches a system of managing images, in which thumbnails contain information unique to users (Col 7, lines 60-65; Col 8, lines 9-19); and information for allowing controlled access by a designated party (Abstract; claim 1, Col 8, lines 8-19, 44-57; Col 9, lines 34-42)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to have icons containing information unique to users and information for allowing access. The motivation for the suggested combination is that the combined teachings would enhance Angiulo's system by distinguishing each thumbnail, thus allowing selective viewing of pictures by users, and based on the decision of KSR International Co. V. Teleflex Inc., it would have been obvious to combine the teachings as the combined teachings would achieve a predictable result of allowing searching of thumbnail images as suggested by Watanabe (column 9, lines 9-13).

As per claim 2, Angiulo teaches the system according to claim 1 wherein said device for creating said electronic icon comprises a user computer (Col 7, lines 45-57; Col 9, lines 10-26. User computer.) and said digital media file is stored in a memory device in said computer (Col 7, lines 30-32; Col 9, lines 20-22. Original image on computer.).

As per claim 4, Angiulo teaches the system according to claim 1 further comprising a communication device for transferring said digital media file from said user computer over said

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communication network (Col 9, lines 20-22. Image stored on computer. Col 11, lines 46-49. Display original image.).

As per claim 9, Angiulo teaches the system according to claim 2 wherein a service provider having access to said digital media file so as to obtain said icon and allow access in accordance with said information (Col 9, lines 5-10, 20-23. Thumbnail is associated with original image. Server has access to original image.).

As per claim 12, Angiulo teaches the method according to claim 11 wherein said information comprises instruction with respect to said digital image files (Col 11, lines 36-38. Link attribute for accessing the original image.).

As per claim 13, Angiulo teaches the method according to claim 12 wherein said instructions comprises forwarding said digital media file to said designated third party (Col 9, lines 5-23. Original image is displayed to a user.).

As per claim 14, Angiulo teaches the method according to claim 13, wherein said instructions comprises forwarding the electronic address of said digital media file to said designated third party such that said designated third party may directly access said digital media file (Col 11, lines 36-38. Link attribute for accessing the original image.).

Claims 3, 5-6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angiulo and Watanabe, in view of Tomat et al, US Patent #6,784,925 (Tomat hereinafter).

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As per claim 3, Angiulo does not teach the system according to claim 1 wherein an electronic camera is used to create said electronic icon and automatically associates said electronic icon with digital image file captured by said electronic camera.

Tomat teaches of an electronic camera used to create thumbnails, e.g. icons, (Col 6, lines 9-19) and associates thumbnails with the full image files (Col 8, lines 1-12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings because the teachings of Tomat to use a camera to create thumbnails and associate the thumbnails with the full images would improve the efficiency of the suggested system by allowing for the previewing images of the full-resolution image and providing another method of generating thumbnails.

As per claim 5, Angiulo teaches of providing instructions for further processing of said digital image (Col 11, lines 36-38. Link attribute for accessing the original image.). However, Angiulo does not teach that the instructions are specifically included with the electronic icon. Angiulo also does not teach the system, wherein said electronic camera has a communication device for transferring said digital media file to a service provider.

Watanabe teaches the concept of including information in a thumbnail (Col 7, lines 60-67; Col 9, lines 9-19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings because the teachings of Watanabe to include information in the thumbnail would improve the suggested system by providing direct association and identification of thumbnail and the original image.

Tomat teaches of transmitting camera images to a service provider (Col 13, line 66 – Col 14, line 6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Angiulo, Watanabe, Tomat because the teachings of Tomat to transmitting camera files to a service provider would enhance the system of Angiulo and Watanabe by allowing for the sharing of pictures taken from a camera.

As per claim 6, Angiulo does not teach the system according to claim 5 wherein said provider provides confirmation of receipt of said digital media file to said electronic camera.

Tomat teaches of providing a file upload status dialog, which indicates the transmission of files (Col 14, lines 18-28).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings because the teachings of Tomat to provide a confirmation of receipt of the files would improve the user friendliness of the suggested system by providing an indication of transmission of files so that the user does not have to resend files.

As per claim 8, Angiulo, Watanabe, and Tomat taught the system as according to claim 5. Angiulo further teaches wherein said instructions includes the automatically forwarding of said digital image file to a third party (Col 11, lines 36-49. Identify location of original image and display image.).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Angiulo, Watanabe, and Tomat, in view of Motoyama, US Publication #2001/0054063 (Motoyama hereinafter).

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As per claim 7, Angiulo does not teach the system according to claim 6 wherein said confirmation further includes confirmation of said instructions.

Motoyama teaches the concept of acknowledging the receipt of instruction data from an user (Claim 22).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings because the teachings of Motoyama to acknowledge receiving instructions would improve the suggested system by providing an indication that data was received properly, which would allow the user to perform subsequent actions.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Angiulo, Watanabe, and Tomat, in view of Uchiyama, US Patent #6,731,341 (Uchiyama hereinafter).

As per claim 10, Angiulo does not teach the system according to claim 5 wherein said communication device is a wireless phone.

Uchiyama teaches that an electronic camera may be attached to a cellular phone (Col 12, lines 39-43).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings because the teachings of Uchiyama to have camera attached to a cellular phone would improve the suggested system by allowing images to be transferred and uploaded to an apparatus from various locations without requiring physical connection to a terminal.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Angiulo and Watanabe, in view of "Official Notice".

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As per claim 15, Angiulo teaches that the digital media is a full sized original image.

Angiulo does not specifically teach that the digital media file is a low resolution copy of a higher resolution media file. However, "Official Notice" is taken by the Examiner that the concept of decreasing the resolution of a media file is well known in the art. It would have been obvious to one of ordinary skill in the art to decrease the full sized original image into a smaller resolution because doing so would provide a file of smaller size for storing, and for downloading to users.

#### **(10) Response to Argument**

Appellant argued that:

1) Regarding claims 1 and 11, Angiulo does not teach that the icon contains information allowing access and information unique to a particular user. The thumbnail image of Angiulo contains information to a particular (i.e., original) image not information to particular user as claimed by applicants.

In response, to further clarify Examiner's rejection, Angiulo teaches of a thumbnail image, considered as the claimed electronic icon, including a link attribute to access an original image, the original image considered as the claimed particular digital media file. This is supported by Angiulo in column 11, lines 36-41,

i) "a link attribute is automatically added to (associated with) the thumbnail image. Whenever the user selects the thumbnail image in the Web page, the selection will cause the web browser to activate the link attribute and replace the display of the Web page and the thumbnail image with original image 10.

Since claims 1 and 11 do not specify how information "allows" access to the particular digital media file, Angiulo's teachings of thumbnail's link attribute used to access the original image meets the scopes of "allowing access with respect to a particular digital media file having said icon associated therewith" (claim language). Appellant appears to agree with examiner's interpretation as Appellant admits, "The thumbnail sized image can be inserted into a Web page providing a hyperlink associated to

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the original image. At best, the thumbnail image contains information to a particular (i.e. original) image". Angiulo teaches of the icon including information allowing access to the original image but does not specifically teach of icon containing information unique to a particular user. Watanabe teaches of a thumbnail image containing information unique to a particular user. The feature of "containing information unique to a particular user" will be further addressed in response to argument 2 below.

2) Regarding claims 1 and 11, Watanabe fails to teach or suggest at least a device for creating an electronic icon containing information unique to a particular user including information allowing access with respect to a particular digital media file having said icon associated therewith over a communication by a third party.

In response, it was shown that Angiulo teaches of a device for creating an electronic icon including information allowing access with respect to a particular digital media file having said icon associated therewith. Newton's Telecom Dictionary defines "icon" as a picture or symbol representing an object, tasks, command or choice you can select from a piece of software (Newton's Telecom Dictionary, Definition of Icon, February 2000). Angiulo's teachings of a thumbnail image with the link attribute meets the definition of an icon since the thumbnail image represents an object, i.e. the original image. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Watanabe was combined with Angiulo to teach the feature of the electronic icon containing information unique to a particular user. Watanabe teaches,

ii) "server 15 searches the low resolution image database 16 for the thumbnail images corresponding to the user ID input on the initial screen and reads the images therefrom. This search can be realized by insertion of the user ID in the header of the image files upon image registration." (column 9, lines 10-15)

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iii) "only one user ID is assigned to each user" (column 8, lines 47-48)

Watanabe's user ID is information unique to particular user since the user ID is the only one that is assigned to the user. Furthermore, Watanabe teaches that the user ID is inserted to the thumbnail image, i.e. contained in the thumbnail image, and the user ID is used for searching thumbnail images (col. 9, lines 13-15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the thumbnail image, i.e. the electronic icon, as taught by Angiulo to contain a user ID, i.e. information unique to a particular user, as taught by Watanabe, which would improve Angiulo's system by enabling searching of thumbnail images by using the user ID as suggested by Watanabe. The combined teachings would achieve a predictable result of allowing searching of certain thumbnail images in a database of a web server.

3) Regarding claims 1 and 11, the user is not the same as a third party as claimed by applicant.

The third party is separate and distinct from the user of the icon that associates the icon with the image.

In response, Examiner is not stating that the user is the same as the third party. It was shown in response to argument 1 that Angiulo teaches of an electronic icon "including information allowing access with respect to a particular digital media file having said icon associated therewith" The rest of claim 1 reads, including information allowing access with respect to a particular digital media file having said icon associated therewith over a communication network by a third party." Angiulo teaches that a user uses a device for creating the thumbnail image for accessing the original image. This is supported on column 9, lines 30-34,

iv) "An auto thumbnail tab 62 has been selected causing the display of a plurality of options that may be selected by a user for controlling various parameters of the thumbnail image, e.g., thumbnail image 12, that the user wants to provide in the Web page to represent the original just selected by the user."

Angiulo teaches that the thumbnail image, considered as the claimed electronic icon, allows access to the original image, considered as the claimed particular digital media, but does not explicitly teach of access by a "third party". Anigulo's thumbnail image is placed on a web page (column 9, lines 33-35. "thumbnail image, e.g., thumbnail image 12, that the user wants to provide in the Web page... column 11, lines 37-39. "thumbnail image in the Web page"), and Angiulo teaches that a "site at which documents are made available to network users through a web server is called a Web site" (column 4, lines 1-2). It is also well known in the art that any user including a user that creates content on a web page are able to access content on a public web page. For instance, for the United States Patent and Trademark Office (USPTO) home page, any user with Internet access including patent examiners, attorneys, a creator of content, e.g. a web master, are able to access links and images on the home page. Angiulo's thumbnail image on a web page is intended for access by users on the Internet (third parties) in addition to the user responsible for creating the thumbnail image, and the access to the thumbnail image is also over communication network since users connect to network, i.e. Internet, to access the web page.

Angiulo's thumbnail image includes information allowing access to an original image, and by a third party accessing the thumbnail image, the thumbnail image allows the third party to access the original image over a communications network. Therefore, Angiulo teaches an electronic icon "including information allowing access with respect to a particular digital media file having said icon associated therewith over a communication network by a third party."

4) Regarding claims 1 and 11, in Watanabe, a user must input a user ID and user password at a browser. The ID of the album does not refer to information for allowing a third party to have access to the image. In sharp contrast, in Applicant's invention, the electronic icon contains information unique to a particular user including information allowing access with respect to a particular digital media.

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In response, it appears that Appellant argues that the information unique to the particular user allows access to the particular digital media. Examiner respectfully disagrees since claims 1 and 11 do not specifically claim that the information unique to a particular user allows access to a particular digital media. Claim 1 recites, *inter alia*, "electronic icon containing information unique to a particular user including information allowing access with respect to a particular digital media file." Claim 11 recites, *inter alia*, "creating an electronic icon containing information unique to said user that includes information for allowing controlled access by a designated third party to a particular digital media file..." Regarding the feature of "including information allowing access with respect to a particular digital file" and "that includes information for allowing controlled access", it may be interpreted such that the electronic icon includes information allowing access with respect to a particular digital file, and the claims are not limited such that the information allowing access is specifically included with information unique to particular user. Claims 1 and 11 do not specify how information "allows" access to the particular digital media file. Angiulo teaches that selecting the thumbnail image added with a link attribute causes the display of an original image. Therefore, the thumbnail image includes information to "allow" access to the original image. The access is also "controlled" since the link attribute guides, by providing coding and rules, the third party to access the original image.

Examiner pointed to the user ID and album ID in Watanabe to show that different types information unique to a particular user may be contained in a thumbnail image. As showed by above quoted sections of (ii)-(iii), Watanabe's user ID is information unique to particular user since the user ID is the only one that is assigned to the user. Watanabe further teaches,

v) "each of the thumbnail images 25 is stored in an image file and the correspondence is stored by describing the name of an album (or an album ID or the like indicating the album)... the WWW application server 15 sequentially confirms the file header of the thumbnail image 25 registered by the user and displays the thumbnail image when the album name specified by the user is included in the header..." (column 8, lines 9-17)

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The album ID is specified by the user and is used correlate the thumbnail image to different albums. The album ID is also information unique to a particular user since the user describes the album ID. Album IDs should be different for each user since users will provide descriptions based on varying user preferences and contents of the album.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Joshua Joo /JJ/

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